

**REMARKS**

- 1      1. Reconsideration of the above identified application is respectfully requested.
- 2      2. Applicants traverse the rejection of claims 1-29 and 31 under Section 103(a) over Smith,
- 3          Slagsvol, and Lane.
- 4      3. An appeal brief was filed on 01/19/2007 in response to the final office action dated
- 5          12/08/2006 noting the long history of this application, including the multiple office
- 6          actions.
- 7      4. The examiner filed an Answer nine months later on 10/26/2007.
- 8      5. The Board of Appeals issued a Remand ten more months later on 08/29/2008 finding
- 9          significant errors and faults in the examiner's Answer, and ordering correction thereof in
- 10          a corrected Answer.
- 11     6. Instead, the examiner, with approval of a supervisor, reopened prosecution de novo in the
- 12          latest office action dated 10/29/2008.
- 13     7. The Board having fully reversed this same examiner in copending application
- 14          11/013,561 suggested that the examiner reconsider the use of reference Lane, common to
- 15          both applications, for more claims than presently applied.
- 16     8. Following that suggestion, the examiner has used the conspicuous expedient of merely
- 17          copying verbatim in the present office action under para. 4 entire sections from the
- 18          previous final office action and merely re-applying reference Lane to the previously
- 19          applied references Smith and Slagsvol for all claims 1-29 and 31 with little distinction or
- 20          further cogent analysis.
- 21     9. The examiner has treated these three disparate references in the aggregate, as nothing
- 22          more than parts bins from which to select naked elements and combine them using
- 23          Applicants' claims as the sole guide in conspicuous hindsight reconstruction devoid of
- 24          evidentiary basis, logic, or the requisite legal motivation mandated in MPEP ch. 2100.
- 25     10. Indeed, the examiner has repeatedly failed to afford any weight to certain claim
- 26          limitations, without due cause, in blatant disregard of the express support in Applicants'
- 27          specification repeatedly overlooked by the examiner in the continued rush to reject all
- 28          claims using the expedient of copying previous rejections.
- 29     11. The examiner has misapplied case law, without the requisite showing of similar facts
- 30          before applying such case law.
- 31     12. And, to the extent the examiner has merely repeated, again and again, previous
- 32          arguments, then Applicants hereby traverse again those repeated arguments and

- 1 incorporate by reference the previously filed appeal Brief which addresses those issues.
- 2 13. The Board has noted the substantial errors in the examiner's rejections.
- 3 14. The Board, itself, has now sufficiently reviewed this application to suggest that the
- 4 examiner reconsider the Lane reference.
- 5 15. We now have a patent application that has undergone substantial scrutiny by the
- 6 examiner, the supervisor, and the Board, itself; with the latest office action combining
- 7 three disparate references in the desperate attempt to fabricate rejections under Section
- 8 103.
- 9 16. This plain history of examination by experienced examiner, supervisor, and Board
- 10 17. appears to be evidence in and of itself of the patentable novelty of the very claims being
- 11 reviewed and rejected; since it has now taken such multiple experienced personnel in the
- 12 PTO to fabricate rejections in the guise of one skilled in the art.
- 13 18. The multiple personnel of the PTO clearly create a much greater standard than one
- 14 merely skilled in the art, and the concerted action thereof per se fails to meet the express
- 15 requirements of Section 103.
- 16 19. On 02/25/2009, a phone interview was held between the undersigned attorney and
- 17 examiner Nordmeyer and supervisor Dye to briefly review the Remand and reopening of
- 18 prosecution in the failed attempt to obtain constructive suggestions from the examiner
- 19 and supervisor to overcome the admitted failure to afford any weight to express features,
- 20 including the preamble features, in particular under the preamble case law of Kropa and
- 21 its progeny found in MPEP 2111.02 (see Brief 47).
- 22 20. However, neither the supervisor nor the examiner were able to offer any constructive
- 23 suggestions, and, therefore, no agreement was reached.
- 24 21. Although it was preferred that the examiner would have been responsive to the Board in
- 25 filing the requested corrected Answer, the examiner, and supervisor, have chosen to
- 26 reopen prosecution.
- 27 22. In view of the failure of the interview to generate constructive suggestions in promoting
- 28 the prosecution of this application, the entire file history has been carefully reviewed in
- 29 the present attempt to alleviate the examiner's admitted failures to afford weight to
- 30 significant features of the claim.
- 31 23. Since the examiner could not offer any constructive suggestions, at all, for any of the
- 32 multiple claims of record, then the present omnibus amendment is being made to provide
- 33 the examiner, and her supervisor, and possibly the Board if (likely) required, further
- 34 variations of features of the quite novel label roll disclosed in the specification, and now

- 1       recited in multiple claims for the examiner's thorough review under Rule 104, now under  
2       the de novo reopening of prosecution.
- 3       24. We, therefore, begin anew the prosecution of the present application; and it is expected  
4       that the examiner will also begin anew to thoroughly and fully evaluating all claims now  
5       of record, without using the simple expedient of merely copying the previous rejections  
6       of record, with minor changes; now being made inappropriate by the present claim  
7       amendment.
- 8       25. Firstly, claim 29 is being canceled, without prejudice, in view of the corresponding scope  
9       of claims 17 and 22.
- 10      26. Since the examiner has repeatedly failed to afford any weight to the label rolls being  
11      recited, remaining claims 1-28 and 31 are being similarly amended to specifically recite  
12      the thermal paper species of the label roll as disclosed in para. 25.
- 13      27. The Background introduces the special problems for specialty labels in the fast food  
14      industry in which label rolls are used to print adhesive labels in high volume (see Brief  
15      6).
- 16      28. And the common high volume label roll is made of thermal paper found ubiquitous in its  
17      simple roll form, but with the attendant disadvantages being solved by Applicants.
- 18      29. This simple amendment of all claims 1-28 and 31 renders moot the examiner's previous  
19      use of Slagsvol for its disparate tracing paper and non-analogous art, as well as Lane for  
20      its disparate specialty labels and non-analogous art, both of which are neither configured  
21      for nor usable in the requisite thermal printer application.
- 22      30. And, Smith discloses a further disparate linerless label configuration subject to many, if  
23      not all, the present problems when used in a printer.
- 24      31. Accordingly, this simple amendment of claims 1-28 and 31 renders moot the examiner's  
25      present rejection thereof.
- 26      32. Furthermore, claim 1 has been additionally amended to recite the form of the wound web  
27      as disclosed in para. 28 which has no relevant counterpart in the applied references.
- 28      33. Claim 2 has been amended to emphasize the special form of the labels shown in Figure 1  
29      which extend transversely across the web in cantilever from the adhesive column to  
30      permit hand grasping of the adhesive-free remaining area to solve the significant  
31      handling problem disclosed in the Background.
- 32      34. None of the applied references discloses any such form for use in a thermal printer to  
33      solve this stated problem.
- 34      35. Dependent claims 3-18 recite additional features having substantial differences over the

1 applied references as presented in the Brief, incorporated herein by reference; which  
2 differences are further significant in view of the thermal paper also recited that is specific  
3 to the label printing roll for which the examiner has previously failed to afford due  
4 weight.

5 36. Independent claim 19 has been amended to recite in the preamble the special form of  
6 printer 10 introduced at para. 21 and including a feedpath terminating in the platen roller  
7 24, direct thermal printing head 26, and cutting blade 28 disclosed in paras. 24-26; none  
8 of which have any counterpart in the applied references.

9 37. The recited label roll 18 has corresponding features defined in part by that special printer  
10 10 in the preamble, including the front surface 34 for thermal printing, and the opposite  
11 back surface 36 containing the columnar adhesive patches 38 that solve the additional  
12 problem of adhesive buildup in the printer, while laterally or transversely presenting the  
13 label 12 for manually grasping the adhesive-free cantilevered portion thereof.

14 38. No such features or advantages are found in the three disparate references previously  
15 applied.

16 39. Claim 25 has been amended to emphasize the cooperation of the index sensor 30  
17 disclosed at para. 27 in defining the individual labels 12, with the majority thereof being  
18 cantilevered for hand-grasping as disclosed at para. 35, with no counterpart in the applied  
19 references.

20 40. The additional dependent claims 20-24 and 26-28 enjoy the substantial differences in  
21 structure and attendant benefits disclosed in the specification, and previously addressed  
22 in the Brief, which are additionally distinguishable in view of the specific thermal paper  
23 form of the label roll for the intended high-volume printer application.

24 41. The preamble amendment of independent claim 19 conforms with the case law on  
25 preambles found in MPEP 2111.02, including the Kropa case and its progeny.

26 42. The examiner should expend the requisite time under the Rule 104 thoroughness standard  
27 to evaluate in full this MPEP 2111.02 provision, and the relevant case law therein.

28 43. The preamble of claim 19 is clearly much more than "mere intended use," and breathes  
29 life and meaning to claims 19-28 in defining the inherent or express nature of the label  
30 roll being recited, in contradistinction from the irrelevant tracing paper of Slagsvol and  
31 stickers of Lane; with corresponding differences over the linerless labels of Smith.

32 44. In the past, the examiner has failed to afford due weight to these features.

33 45. Now, the examiner must afford due weight, and, if not, the examiner should present  
34 suitable remarks for consideration both by this attorney, as well as the Board in the event

- 1 another appeal is required.
- 2 46. The Board found substantial fault with the examiner's previous Answer, which the  
3 examiner chose not to correct, but chose instead to reopen prosecution. If another appeal  
4 is required, then the examiner is now on express notice to ensure that the next-action  
5 remarks are duly specific, appropriately thorough, and fully complete to present specific  
6 issues and support therefor for review by the Board, without another remand by the  
7 Board for further fault.
- 8 47. Independent claim 31 has been similarly amended like independent claim 19 to introduce  
9 the printer 10 in the preamble, along with its feedpath features, with the body of the claim  
10 reciting the corresponding thermal paper form of the web 20 with one surface 36 facing  
11 inwardly to engage the platen roller 24, and the opposite surface 34 carrying the release  
12 strip 40.
- 13 48. The labels extend transversely to cantilever from the adhesive column 38 for hand  
14 grasping, and cutting in the adhesive-free portion.
- 15 49. Like claim 19, claim 31 lacks any counterpart in the disparate references previously  
16 applied, which have different configurations and cooperation for different purpose and  
17 solving different problems.
- 18 50. In this regard, note the Board's suggestion at Remand 3 that Lane teaches that "... cutting  
19 can occur without fouling or gumming of the cutting knife (see, e.g., Lane, p. 3, col. 1, ll.  
20 11-44)."
- 21 51. Firstly, it should be noted that that suggestion was applied to the previous claims, before  
22 the present amendment, and is no longer relevant thereto.
- 23 52. Secondly, that teaching has been taken out of context by the Board, and is an isolated  
24 teaching without regard to the two other disparate references applied by the examiner,  
25 which lack any such problem or any need for solution.
- 26 53. Note that the p. 3 description identified by the Board has special configurations also  
27 disclosed by Lane, and lacks nexus with the disparate references Smith and Slagsvol.
- 28 54. In Smith, no such problem is disclosed requiring the Board's "solution" from Lane. And,  
29 the Board has failed to explain how Smith would have been modified in any manner  
30 relevant to Applicants' claims.
- 31 55. In Slagsvol, no such problem is disclosed also requiring the Board's "solution" from  
32 Lane. And, the Board has failed to explain how Smith or Slagsvol in combination  
33 therewith would have been modified in any manner relevant to Applicants' claims.
- 34 56. It appears that the Board, also, is being trapped in the ever so easy use of impermissible

- 1 hindsight, and selectively extracting isolated features for isolated reasons without regard  
2 to the whole, or applicable patent law under Section 103.
- 3 57. Note further, that the Board did not conduct the requisite thorough analysis under Section  
4 103, but simply noted the faults in the examiner's Answer, and left correction of those  
5 faults to the examiner, with further instructions to consider "whether Lane should be  
6 relied upon in all of the rejections ...."
- 7 58. The examiner took that suggestion blindly, and merely re-applied Lane to all the claims  
8 instead of to only claims 10,16,26 as found in paras. 5 & 8 of the previous final office  
9 action.
- 10 59. The examiner has been well aware of the Lane reference; has previously applied that  
11 reference; and now, with the suggestion of the Board, has re-applied that reference even  
12 more blindly than before, and without due regard to the express requirements under  
13 Section 103.
- 14 60. The examiner's various contentions are mostly bald assertions, resulting in mere  
15 conclusions of obviousness, without due regard to requisite evidentiary showings, and  
16 without any showing of legal motivation, and its various forms presented in substantial  
17 detail in MPEP ch. 2100.
- 18 61. To be certain, Lane may disclose various packages of gummed bands or stickers, but  
19 those bands and stickers have special, and multiple, configurations for special "intended  
20 use" or purpose, but equally certain is that Lane is not a thermal paper label roll for use in  
21 a thermal printer; and solves different problems for different applications,  
22 notwithstanding the out-of-context "suggestion" by the Board.
- 23 62. That Board has not supplanted the examiner in meeting the thoroughness standard under  
24 Rule 104, and therefore that out-of-context suggestion by the Board should be given  
25 little, if any, weight for the previous claims, and especially for the claims as now  
26 amended.
- 27 63. Method claim 32 has been added to depend from claim 2 to introduce the printer 10  
28 shown in Figures 1-3, and its method of use with the installed label roll 18 as disclosed at  
29 paras. 21-27 and 32-36.
- 30 64. Not one of the applied references discloses or suggests any use of the products therein in  
31 a thermal printer in the express combination of features and benefits attributable to claim  
32 32, which renders claim 32 patentably distinct.
- 33 65. Of course, linerless labels are commonly used in printers; but claim 32 recites a special  
34 label roll for special use and advantage in the printer being recited.

- 1 66. Claim 33 has been added to depend from claim 19 and recites the express combination of  
2 the special label roll 18 in that printer 10, which will then be effective for practicing the  
3 method. The same paras. 21-27 and 32-36 disclose this combination of features having  
4 no counterpart in the applied references, and therefore well patentably distinguishable  
5 thereover.
- 6 67. Yet again, in view of the substantial novelty of Applicants' label roll and its columnar  
7 adhesive configuration, independent claim 34 is being added and was copied from  
8 original claim 1, and is therefore supported thereby, but has been amended to specifically  
9 recite the thermal paper web species disclosed at para. 25 with discrete adhesive patches;  
10 which yet again lacks counterpart in the applied references, over which this claim is  
11 therefore patentably distinct.
- 12 68. Added claim 35 depends from claim 34, and was copied from original claim 2, and  
13 amended to recite the cantilever form of the labels as disclosed at para. 35.
- 14 69. None of the applied references discloses analogous structure for analogous use, and  
15 therefore claim 35 is patentably distinguishable thereover.
- 16 70. Another group of claims 36-48 is also being added and were copied in most part from  
17 previously amended claims 1, 2, 4, 5, 7-10, and 13-17, and obtain support therefrom, and  
18 additionally amended to emphasize features additionally disclosed in the specification.
- 19 71. However, independent claim 36 has been further amended from previous claim 1 to  
20 introduce in the preamble the printer 10 and its feedpath features as similarly recited in  
21 amended claim 19, and has corresponding support therefor in the specification.
- 22 72. The web 20 is formed of label printing material as disclosed at para. 28 arranged in the  
23 roll and sized to mount inside the printer 10 shown in Figures 1-3, and described at paras.  
24 21. et seq.
- 25 73. The front surface 34 faces outwardly for printing by the head 26, and the back surface 36  
26 faces inwardly to engage the platen roller 24 during operation as disclosed at para. 32.
- 27 74. The columnar adhesive 38 covers the minor area of the back surface 36 for reducing  
28 surface area exposure along the feedpath and over the platen roller 24 as disclosed at  
29 para. 30.
- 30 75. The adhesive-free spaces allow blade cutting thereof as disclosed at paras. 36 & 40.
- 31 76. This configuration of the thermal paper label roll enjoys many advantages as well  
32 disclosed in the specification, and lacks counterpart in the applied references as  
33 previously presented above.
- 34 77. Claim 37 was copied from claim 2 and further introduces the narrow column of adhesive

1        38 as disclosed at paras. 29, 31, 35, 37, and 45 cooperating with the larger adhesive-free  
2        remainder for several advantages disclosed in the specification, including the hand  
3        grasping thereof, especially when the user wears gloves for sanitary reasons in the fast  
4        food industry.

5        78. Claim 38 was copied from claim 4 for the narrow longitudinal patches 38 species  
6        disclosed at para. 43 lacking counterpart in the disparate references applied.

7        79. Claim 39 was copied from claim 5 for the wide transverse patches 38C shown in Figure 8  
8        and disclosed at para. 46, yet again having no counterpart in the applied references.

9        80. Claim 40 was copied from claim 7 for the narrow patches 38 species which reduce  
10       adhesive surface area while correspondingly increasing the cantilevered adhesive-free  
11       remainder as disclosed at para. 30; and, yet again lacks counterpart in the applied  
12       references.

13       81. Claim 41 was copied from claim 9 for reciting the short and wide species of the patches  
14       38C shown in Figure 8 and disclosed at para. 46; again lacking counterpart in the applied  
15       references.

16       82. Claim 42 was copied from claim 8 to introduce the index sensor 30 shown in Figure 3  
17       and disclosed at para 39; with which the recited index marks cooperate as disclosed at  
18       para. 39 for defining the cantilevered labels disclosed at para. 35, without counterpart in  
19       the applied references.

20       83. Claim 43 was copied from claim 10 to recite the plural small patches 38C species shown  
21       in Figure 8 and disclosed at para.47 for variable label size including multiple patches per  
22       label having no counterpart in the applied references.

23       84. Claim 44 is a new dependent claim specifically reciting the thermal paper species of the  
24       web 20 as introduced at para. 25 for its substantial advantages in forming the label roll  
25       having utility in the thermal printer 10, yet again having no counterpart in the disparate  
26       references applied.

27       85. Claim 45 was copied from claim 13 to specify the enhanced function of the arcuate edges  
28       for transitioning onto and off the platen roller 24 as disclosed at para. 37 which enjoys  
29       the particular advantage disclosed in para. 38 for gradually distributing the adhesive  
30       forces to reduce adhesive buildup, in yet another configuration having no counterpart in  
31       the references.

32       86. Claim 46 was copied from claim 14 for the oval species of the patches 38 disclosed in  
33       para. 37 for the same distribution advantages disclosed above, having no counterpart in  
34       the applied references.



- 1 87. Claim 47 was copied from claim 16 for reciting the thermal paper species of para. 25 and  
2 the corresponding protection of the thermal print thereon from the full surface release  
3 strip 40 as disclosed at paras. 31 & 44, having no counterpart in the applied references.
- 4 88. And, claim 48 was copied from claim 17 for the printing paper species of the web and the  
5 cooperating narrow release strip 40 that permits printing thereatop as disclosed at para.  
6 45 in yet another species having no counterpart in the applied references.
- 7 89. The examiner's repeated arguments presented in para. 4 of the office action have been  
8 previously traversed, and have been additionally rendered moot in view of the above  
9 amendments, and added claims having different features in various combinations.
- 10 90. The examiner's continued use of Slagsvol and added use of Lane in combination with  
11 Smith is mere aggregation of disparate references without regard to the whole thereof,  
12 and without regard to the evidentiary and legal motivation requirements of MPEP ch.  
13 2100 found wanting in the examiner's remarks.
- 14 91. The examiner's "[i]t would have been obvious" assertions on page 5 are mere conclusions  
15 without due evidentiary or legal support.
- 16 92. The examiner's failure to afford any weight to the various species as found at pages 5 & 6  
17 citing Seid and Dailey fails ab initio to apply that case law as mandated by the MPEP,  
18 and repeatedly overlooks Applicants' own specification which "which application does ...  
19 [indeed] indicate any new, significant attributes of the invention..." disregarded by the  
20 examiner in the rush to reject, it being well noted that the examiner has applied three (3)  
21 disparate references in fabricating the rejection, and then simply opines that the various  
22 species lack advantage, because the examiner has not found any relevant teaching in the  
23 applied references.
- 24 93. That "Smith teaches a variety of shapes..." as the examiner contends, is blatantly  
25 irrelevant, and wholly disregards those actual "shapes" or their purpose, having no  
26 relevance to Applicants' "shapes" expressly recited, and expressly supported in the  
27 specification for specific advantage found wanting in Smith.
- 28 94. The examiner's use of "intended use" has been well addressed in the Brief, and has now  
29 been rendered moot in view of the above amendments and applicable case law on the use  
30 of the preamble in defining claim features.
- 31 95. Should the examiner continue to disregard the preamble as now amended, then the  
32 examiner should clearly present due support in the MPEP and case law for that disregard  
33 in order to present clear issues before the Board.
- 34 96. The examiner should be mindful of the previous Remand by the Board for major faults

1 by the examiner in the Answer, and the Board should not yet again be presented with  
2 further faults or omissions by the examiner for the next appeal (which is likely and  
3 expected).

4 97. Furthermore, method claim 32 and combination claim 33 now positively recite the  
5 printer features for which the examiner has previously asserted "intended use," and the  
6 examiner must, therefore, now evaluate those claims de novo for their express  
7 combination of features.

8 98. As to the examiner's "Response to Arguments" section presented in para. 5, the examiner  
9 has failed to identify what those arguments are. Are they from the Brief, and if so, has  
10 the examiner duly corrected the faults identified by the Board?

11 99. Nevertheless, the examiner's response is traversed based on that very Brief; and that  
12 response by the examiner has been rendered moot in view of the substantial claim  
13 amendments, and additional claims.

14 100. The claims are now different, and the examiner is duty bound under Rule 104 to  
15 conduct a thorough examination of these different claims, for which Slagsvol is clearly  
16 nonanalogous art, and for which Lane is also nonanalogous art.

17 101. And as for Smith, the teachings thereof are irrelevant to the now different claims,  
18 and would more likely teach away from Applicants' claims, than provide any relevant  
19 teaching therefor.

20 102. Case law indicates that the disparate linerless labels of Smith cannot be so  
21 substantially modified by secondary references which would render inoperative those  
22 labels of Smith.

23 103. The examiner should be mindful of the substantial breadth and scope of the  
24 present claims, and the various species recited therein; and that to excessively modify  
25 Smith is to distort that very reference rendering it unrecognizable from itself, and  
26 therefore inoperative.

27 104. Nevertheless, the examiner's voluminous arguments in para. 5 which cover pages  
28 7, 8, 9, 10, 11, 12, and 13, clearly indicate that the examiner is well trained to reject the  
29 claims for innumerable assertions, and disregarding express claim features for various  
30 reasons, be they "intended use" or "variety of shapes" or the blatant disregard of express  
31 MPEP provisions, and the very case law therein, which cannot be merely applied as an  
32 expedient sword in attacking claims and their substance, but require objective analysis,  
33 starting first with the very facts of those cases, and then applying those facts and law to  
34 the claims at hand, if, and only if, relevant.

- 1       105.       "Variety of shapes" the examiner blindly asserts at page 6, citing "Column 3, line  
2       60 to Column 4, line 1; Column 3, lines 42-46" of Smith.
- 3       106.       And what shapes are they? "[D]iscontinuous strips, dots, a series of polygons, or  
4       a wide variety of other patterns."
- 5       107.       Yet, what shapes are these listed items, and where are they shown?
- 6       108.       What purpose or function do these various "shapes" perform, and what  
7       problem(s) do they solve?
- 8       109.       The examiner has clearly overlooked these fundamental issues as an expedient in  
9       first disregarding specific features expressly recited in Applicants' claims, and expressly  
10       supported in the specification for expressly stated benefits, all conveniently overlooked  
11       by the examiner; yet the examiner additionally fails to evaluate the significance, or lack  
12       thereof, of the "variety of shapes" merely listed incidentally in Smith.
- 13       110.       Those shapes are incidental and irrelevant to the whole of the labels disclosed in  
14       Smith; yet the express species recited in Applicants' claims are, to the contrary, quite  
15       significant to those species. Why? Because Applicants so teach, whereas Smith does  
16       not.
- 17       111.       This examiner has not allowed one claim in the present application.
- 18       112.       Nor has this same examiner allowed even one claim in the improvement  
19       application identified in the Brief, for which the Board of Appeals reversed in full the  
20       examiner's equally erroneous assertions of obviousness.
- 21       113.       The examiner has clearly demonstrated during the history of this application, not  
22       to mention the improvement application, a bias against this application and the various  
23       claims therein, notwithstanding the extraordinary review thereof.
- 24       114.       And in the phone interview identified above, the supervisor expressly stated that  
25       neither the supervisor nor the examiner after having re-reviewed the file could offer any  
26       constructive suggestions for any of the claims to overcome the rejections.
- 27       115.       To be certain, the present application contains many patentably novel features,  
28       which are now recited in the various claims now of record.
- 29       116.       To be equally certain, claims will be allowed in this application, either now by  
30       this examiner, or after the next appeal to the Board.
- 31       117.       The undersigned attorney has conducted multiple phone interviews with the  
32       examiner for promoting the prosecution of this application and attempting to overcome  
33       the subjective application by this examiner of the requirements under Section 103.
- 34       118.       The undersigned attorney has attempted to avoid appeal, and would hope that the

1 present claims will now have additional features for overcoming the examiner's  
2 subjective application of the law.

3 119. Reasonable minds will always differ, especially between an examiner and a  
4 patent attorney; but unless the examiner can offer constructive suggestions to overcome  
5 subjective applications of the law, we will be forced to have the Board of Appeals review  
6 this application, in yet more years of examination.

7 120. This Board has already found fault with this examiner's Answer, but the Board's  
8 remand is troubling because of the Board's apparent attempt to steer the examiner to  
9 differently apply both the Smith and Lane references (Remand 3), when the examiner  
10 already has sufficient experience and assistance by the supervisor in thoroughly  
11 evaluating the claims in light of all the references of record.

12 121. Both the examiner and Board are duty bound to evaluate this application  
13 objectively, and the examiner is primarily responsible in meeting that duty; and this  
14 attorney requests, yet again, the cooperation of the examiner in finding allowable subject  
15 matter.

16 122. It would appear that the preamble features have been well argued over the course  
17 of examination, yet the examiner has failed to offer any suggestion on her views in a  
18 distinguishing preamble in accordance with applicable preamble case law, as she would  
19 interpret that case law.

20 123. Surely, the examiner must have sufficient experience to evaluate the most  
21 fundamental feature of all patent claims, i.e. the preamble, and have suitable mastery of  
22 the applicable case law to determine which preamble features to afford weight, and which  
23 not.

24 124. The seminole Kropa case recognizes that preamble recitations can give life and  
25 meaning to patent claims, and the elements recited therein after the preamble. That  
26 analysis is done on a case by case basis.

27 125. But fundamental to that analysis is the cooperation between the preamble features  
28 and the recited elements.

29 126. Many of the claims have now been amended with specific preambles expressly  
30 cooperating with the recited elements.

31 127. Is there any teaching in Smith of using or modifying its labels for use in the  
32 printer in a fast food restaurant?

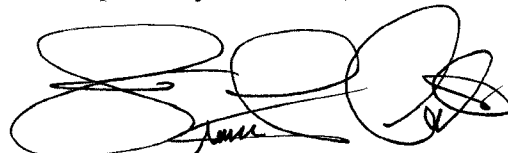
33 128. How about the tracing paper of Slagsvol?

34 129. Or, how about the various species of gummed labels in Lane?

- 1      130.      Clearly not.
- 2      131.      Those three references disclose different configurations for different applications  
3      solving different problems.
- 4      132.      Applicants' label roll is visually quite unique and distinctive, and clearly lacks  
5      counterpart in these three references.
- 6      133.      Why then does the examiner continue to reject the claims, without any suggestion  
7      for emphasizing those plain differences?
- 8      134.      Both the examiner and this attorney have expended inordinate effort in  
9      prosecuting this application. When will this end?
- 10     135.      With renewed cooperation of the examiner, it should be likely that the claims, or  
11     most of these claims, should now be in condition for allowance.
- 12     136.      If not, then the examiner is requested yet again to offer constructive suggestions  
13     in further amending any claim to additionally distinguish over the references being  
14     applied.
- 15     137.      It is now time to allow this application, and if not, then this application will be  
16     appealed to the Board, with the hope that one appeal will be sufficient, instead of  
17     repeated appeals, as may be necessary in the improvement application.
- 18     138.      The examiner should well recognize that notwithstanding the many species  
19     claims recited therein and the examiner's steadfast rejections thereof, the Board of  
20     Appeals fully reversed each and every rejection.
- 21     139.      The remand to the examiner in that case identified a selective use of the Lane  
22     reference, with the present Board again suggesting to the examiner in this application  
23     further consideration of that same reference Lane in the same Remand which otherwise  
24     found error in the examiner's Answer.
- 25     140.      Lane is limited in scope and teaching, and teaches away from Applicants' claims  
26     in most part, notwithstanding the Board's limited use thereof.
- 27     141.      Even the Board itself initially applied Lane erroneously under a Section 102  
28     rejection in the improvement application. And, that Board withdrew that very rejection  
29     after request for reconsideration.
- 30     142.      The Board nevertheless sustained a Section 103 rejection under Lane, but to a  
31     single claim, and even that sustained rejection is without due legal support under Section  
32     103, and will be separately addressed.
- 33     143.      The examiner should not take license, as the examiner has done in the  
34     improvement application, to apply Lane for more than case law permits.

1 144. Lane is a limited reference, and has limited teachings; but the Section 103  
2 analysis requires objective evaluation of the whole of Lane, and the whole of Smith and  
3 Slagsvol, as well as a whole evaluation of each and every one of Applicants' claims.  
4 145. And, proper legal motivation is mandatory under Section 103 in combining  
5 multiple references under Section 103.  
6 146. Such legal motivation is clearly lacking to combine the present references Smith,  
7 Slagsvol, and Lane in any manner relevant to the claims as now presented.  
8 147. Accordingly, withdrawal of the rejection of claims 1-29 and 31 under Section  
9 103(a) over Smith, Slagsvol, and Lane is warranted and is requested.  
10 148. And in view of the above amendments, remaining claims 1-28 and 31-48 should  
11 be in condition for allowance, which is respectfully requested.  
12 149. Please charge the required fee for added claims 32-48, and any deficiency  
13 associated with this amendment, to Deposit Account No. 14-0225 of NCR Corporation in  
14 accordance with the attached Fee Transmittal.

Respectfully submitted,



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Date: 28 February 2009

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Attachment: One-page Fee Transmittal for FY 2009